



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kenji SAMOTO

Group Art Unit: 2831

Application No.: 10/669,687

Examiner: J. LEE

Filed: September 25, 2003

Docket No.: 117213

For: FLEXIBLE CABLE HARNESS AND IMAGE FORMING APPARATUS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests review of the August 28, 2006 Final Rejection ("Final Rejection") in this application. A Notice of Appeal and fee in the amount of \$500 are filed concurrently herewith. Claims 1-15, 19 and 20 are pending in this application. The Final Rejection states that claims 1-8, 19 and 20 stand finally rejected and claims 9-15 are withdrawn as being directed to non-elected claims.

The Final Rejection rejects claims 1-6, 19 and 20 under 35 U.S.C. §103(a) over JP-U-6-21949 (JP'949). Appellant respectfully submits that the rejection contains obvious legal and factual deficiencies.

Claims 1 and 19 recite, in pertinent part, a flexible cable harness with a plurality of flexible cables, each of the plurality of flexible cables comprising (1) a first positioning system added near the first end (each flexible cable having a first end); and (2) a second positioning system added near the second end (each flexible cable have a second end).

Appellant herein points out the obvious factual deficiencies (JP'949 simply discloses cables)

and legal deficiencies (the Office Action fails to point out where JP'949 discloses any structure that is "on" the cables that can be interpreted as being a first positioning system and a second positioning system).

I. JP'949 Simply Discloses Cables

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All the words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In providing the broadest reasonable interpretation in light of the specification for claims 1 and 19, the flexible cable harness must have at least something (i.e., first and second positioning systems) added to two ends of each of the plurality of flexible cables (as well as satisfy the remaining requirements of claims 1 and 19). Appellant is not claiming an image forming apparatus with a flexible cable harness in claims 1 and 19. Appellant is simply claiming a flexible cable harness. JP'949 fails to disclose anything that is added to the flexible cables (cables 13-17) of their flexible cable harness.

JP'949 discloses a flexible cable harness with cables 13-17. JP'949's figures fail to illustrate any structure that is associated with or could be added to the cables 13-17 and JP'949's specification fails to discuss any structure that is associated with or could be added to the cables 13-17. JP'949 thus fails to disclose or suggest each of a plurality of flexible cables comprising a first positioning system added near a first end and a second positioning system added near a second end, as recited in claims 1 and 19.

In JP'949, the cables 13-17 are pressed by a cable presser-foot plate 29 at a first end and by a lateral surface of the carriage 7 at a second end, with the cables 13-17 inserted into splicers 21, 23 (paragraph [0004] of translation).

Appellant observes the following: (1) each of the presser-foot plate 29, carriage 7 and splicers 21, 23 are a part of the image forming apparatus, which the Examiner admits is a distinct combination from the sub-combination of a flexible cable harness (see December 15, 2005 Restriction Requirement), (2) it is not logical, nor would one skilled in the art state that structure from an image forming apparatus (i.e., a combination) is added to a flexible cable harness (i.e., a sub-combination), (3) if JP'949's flexible cable harness (cables 13-17) is removed from the image forming apparatus, nothing would be present at the end of the cables 13-17 and (4) JP'949's flexible cable harness (cables 13-17) does not have any structure that can achieve the advantages of simplifying the manufacturing of various flexible cables, reducing production costs and minimizing positioning fluctuations, which can be achieved by using a plurality of flexible cables that each include the added first and second positioning systems of claims 1 and 19 (paragraphs [0036] - [0038] of Applicant's specification, for example).

JP'949 thus fails to disclose or suggest a flexible cable harness with each of a plurality of flexible cables comprising a first positioning system added near a first end and a second positioning system added near a second end, as recited in claims 1 and 19.

II. The Office Action Fails To Point Out Where JP'949 Discloses Any Structure That Is "On" The Cables

It is well settled that a rejection based on 35 U.S.C. §103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. *In re GPAC, Inc.*, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). This showing must be clear and particular. Broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See *Dembiczak*, 175 F.3d at 1000, 50 USPQ2d at 1617. Appellant asserts that the Final Rejection does not clearly point out where JP'949 discloses all of the features recited in claims 1 and 19.

Page 2 of the Final Rejection identifies "unnumbered on the cables at 29 for example" and "unnumbered on the cables at 21, 23 for example" as a first positioning system and a second positioning system. JP'949 fails to disclose any structure or positioning system that is "on" the cables 13-17 at 21, 23, and 29 as asserted in the Final Rejection that can be added to each of a plurality of flexible cables as recited in claims 1 and 19. Furthermore, the February 6, 2006 Advisory Action fails to clarify this issue by stating that a first positioning system and a second positioning system are "at" 21, 23 and 29.

Appellant cannot not determine what the Examiner considers to be "on" or "at" the cables 13-17 because JP'949 simply discloses cables 13-17 attached to a cable presser-foot plate 29 and splicers 21, 23 of an image forming apparatus. Appellant thus cannot determine what the Examiner considers to be first and second positioning systems that are added to each of JP'949's cables 13-17.

It would not have been obvious to add structure that does not exist. By failing to disclose any structure (i.e., first and second positioning systems of claims 1 and 19) that is "on" the cables 13-17 or could be added to the cables 13-17, JP'949 thus fails to disclose or suggest each of a plurality of flexible cables comprising a first positioning system added near a first end and a second positioning system added near a second end, as recited in claims 1 and 19.

III. Conclusion

For at least these reasons, the Final rejection includes legal and factual deficiencies and also fails to establish a case of obviousness. Because the prior art fails to disclose each and every feature recited in the independent claims, withdrawal of the Final Rejection and allowance of this application are respectfully requested.

Respectfully submitted,



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Attachments:

Notice of Appeal and Petition for Extension of Time

Date: February 28, 2007

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